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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,794	10/12/2000	Matthew Parrish	10002096-1	8526

22879 7590 06/28/2004

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EXAMINER

DUONG, OANH L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 06/28/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No	Applicant(s)	
	09/687,794	PARRISH ET AL.	
	Examiner	Art Unit	
	Oanh L. Duong	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27, 29-39, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 28 an 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed 04/19/2004 have been fully considered but they are not persuasive.

In the remarks, applicants argued in the substance that:

(A) Prior art does not teach the web page to be displayed to the user.

As to point (A), Kirsch teaches "**a web page** served by an HTTPd server system...to client 12 **embeds a URL reference. Selection of this embedded URL through client browser** of the client system 12..." (col. 7 lines 10-17). The Web page is inherently displayed to the user in order for the user to select the embedded URL in the webpage, thereby allowing the user to quickly and conveniently retrieve more specific information.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a BIT tag is a HTML image tag (or equivalent) with a BIT URL, i.e., a URL that includes embedded user information and a broken image file designator. As used herein, a broken image file is a file that cannot be located, e.g., because it does not exist or because its directory path does not point to it" are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

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the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Allowable Subject Matter

2. Claims 28 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 22-25, 29-30, 36-38 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by (Kirsch) (US 6,466,966 B1).

Regarding claim 22, Kirsch teaches a method for tracking the use of a web tool by a web user (e.g., see col. 5 lines 8-27), comprising providing a web user through a web user computer access to a web tool (search engine) (e.g., see col. 1 lines 52-56); in response to the user accessing the web tool, inserting (embedding) within at least one or more web page files (web pages) a Broken Image Tracking (BIT) tag (read as a HTML image tag) that includes user information (read as client or account identifier, NwPg) associated with the web user's use of the web tool and a BIT URL designating a server (HTTPd server system 16, col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40); transmitting from the user web tool to the web user computer one or more web page files in connection with the user accessing the web tool (a web page served by an HTTPd server 16 to client 12, col. 1 lines 56-64 and col. 7 lines 10-13); wherein the one

or more web page files are displayed to the web user (a web page must be displayed to client browser before client can select an embedded link in the web page) (col. 1 lines 51-59 and col. 7 lines 14-17), and the one or more web page files and the BIT tag are configured to be executed by the user computer (web page is served, and click/select of the embedded link in the web page, col. 7 lines 6-23 and col. 8 lines 19-40), the user information is transmitted from the user computer directly to the designated server (col. 5 lines 23-27 and col. 16 lines 17-25); and storing the user information in a database (the persistent mass storage device 32) identified by the designated server (col. 11 line 4-45 and col. 12 lines 32-33).

Regarding claims 23, Kirsch teaches mark up language image tag (e.g., see col. 12 lines 5-15 and col. 8 lines 19-40).

Regarding claim 24, Kirsch teaches the user information embedded in the BIT URL (col. 16 lines 18-20).

Regarding claim 25, Kirsch teaches web tool is provided to a plurality of web users with each user receiving at least one web page including a BIT tag (HTML image tag) with embedded user information (account identifier), wherein the user information for each user is transmitted to the designated server (HTTPd server, abstract, col. 7 lines 6-23 and col. 8 lines 19-40).

Regarding claim 29, Kirsch teaches inserting the BIT tag in the at least one web page file so that it causes substantially no error graphic to be displayed to the user in response to an image file designated with the command not being retrieved (col. 7 lines 6-23).

Regarding claim 30, Kirsch teaches a system for tracking web users' use of a web tool, comprising a web tool server configured to be operatively connected to one or more web user computers (fig. 1), the web tool server including a web tool program configured to provide to each web user computer one or more web page files in a web tool session (col. 1 lines 51-64), the web tool server configured to insert within at least one of the web page files associated with the session a Broken Image Tracking (BIT) tag including a BIT URL and embedded user information associated with the web user's use of the web tool (col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40), and wherein the web tool is configured to provide the at least one web page to the web user computer to be displayed by the web user computer (col. 1 lines 51-64); and the at least one web page and the BIT tag are configured to be executed by the web user computer after the web page have been received by the user computer (col. 7 lines 10-23); and a designated server identified in the BIT URL and configured to be operably connected to the one or more web user computers (col. 8 lines 31-45), wherein the web page file and the BIT tag, when executed by the web user computer, cause the web user computer to transmit to the designated server the user information (col. 7 lines 10-17 and col. 20 lines 15 lines 17-25), and further wherein the designated server is configured to store the user information (col. 11 lines 4-9).

Regarding claim 36, Kirsch teaches the BIT tag is implemented with a mark-up language tag (col. 12 lines 5-15 and col. 8 lines 19-40).

Regarding claim 37, Kirsch teaches an HTML image tag (col. 12 lines 5-15).

Regarding claim 38, Kirsch teaches the Web tool server (HTTPd server) and designated server (designated tracking HTTPd server system) are implemented in the same server (server system 16, seen in col. 6 lines 53-60).

Regarding claim 42, Kirsch teaches a computer program product for tracking the use of a web tool by a web user (e.g., see col. 5 lines 8-27), the product comprising computer readable instructions thereon that when executed cause a computer to perform the following acts providing a web user through a web user computer access to a web tool (e.g., see col. 1 lines 52-56); in response to the user accessing the web tool, inserting within at least one or more web page files, using the web tool, a Broken Image Tracking (BIT) tag including a BIT URL and embedded user information associated with the web user's use of the web tool (col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40); transmitting from the user web wool to the web user computer one or more web page files (e.g., see col. 1 lines 56-64); and wherein upon receipt of the web page file by the web user computer, the one or more the one or more web page files are configured to be displayed to the user (col. 1 lines 51-59), and the one or more web page files and the BIT tag are configured to be executed by the user computer upon receipt of the web page file by the web user computer (abstract, col. 7 lines 6-23 and col. 8 lines 19-40); the web page file is configured such that, upon execution of the web page file and the BIT tag by the web user computer, the BIT URL is transmitted to a designated server (col. 7 line 51-col. 8 line2 and col. 8 lines 19-22); and the BIT URL is configured such that, in response to the BIT URL being processed by the designated server (col. 16 lines 23-25), the user information is stored in a database (col. 11 line 4-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-27, 31-35, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch in view of Jennings, III et al. (Jennings) (US 2003/0220998 A1).

Regarding claims 26 and 27, Kirsch does not explicitly teach the user information is stored in an error log as claimed. However, Jennings, in the same field of endeavor, teaches the user information is stored in an error log within the designated server (server's log file include: the client's network address, the file being requested...error, in page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph 0002). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 31, Kirsch does not explicitly teach an error log. However, Jennings, in the same field of endeavor, teaches an error log/log file (server's log file, page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph

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0002). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 32, Kirsch teaches implement the designated server as a web server (HTTPd server 30, in fig. 2). Kirsch does not teach an error log. Jennings, in the same field of endeavor, teaches Internet programs stores user information from the request into the error log in response to an error being generated by the request at the designated server (server's log file include: the client's network address, the file being requested...error, in page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph 0002). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 33, Kirsch/Jennings teaches the BIT URL designates a broken image file (Kirsch, col. 6 lines 38-60 and col. 7line 51-col. 8 line 40); file that cannot be found within the designated server, which causes the error to be generated by the Internet program (Jennings, in page 2 paragraph 27).

Regarding claim 34, Kirsch/Jennings teaches a web server with an error log (Jennings, in page 2 paragraph 27), the user information is stored in the database separate from the error log (Kirsch, storage 32, in fig. 2, col. 11 lines 39-45).

Regarding claim 35, Kirsch/Jennings teaches storing user information in database (Kirsch, col. 11 lines 39-45).

Regarding claim 39, Kirsch teaches a web tool system having a capacity of tracking a users' use of a web tool, comprising a web tool server communicatively linked to a web user computer for providing a web user with access to a web tool (fig. 1), the web tool server including a web tool program configured generate and provide to the web user computer one or more web page files in connection with the web user engaging in a session the web tool (col. 1 lines 51-64), the web tool server further being configured to include in the one of the web page files a Broken Image Tracking (BIT) tag including a BIT URL and embedded user information associated with the web user's use of the web tool (col. 6 lines 38-60 and col. 7 line 51-col. 8 line 40), and wherein the at least one web page file and the BIT tag are configured to be executed by the user computer after the web page has been received by the web user computer (col. 7 lines 10-23); and the at least one web page file is configured to be displayed by the web user computer (col. 1 lines 51-64); and designated server identified in the BIT URL and communicatively linked to the web user computer (col. 8 lines 31-45); a user information database server communicatively linked to the designated server, wherein the designated server is configured to transfer the user information from the BIT URL to the user information database in response to processing the BIT URL (col. 11 lines 5-9). Kirsch does not explicitly teach an error log. Jennings, in the same field of endeavor, teaches the designated server including a web server with an error log (page 2 paragraph 27). Jennings teaches the use of log files would reduce the time it takes for a client to obtain the content it requests from a server (page 1, paragraph 0002). It would

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have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the error-log/log-file of Jennings in the server of Kirsch.

Regarding claim 41, Kirsch teaches BIT URL (HTML image tag) causes the designated server to generate a broken image file designation (read as image file, i.e., MTCH1073.gif, in col. 12 lines 14-15).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

O.D
June 20, 2004


PATRICE WINDER
PRIMARY EXAMINER